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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/680,830	08/12/2005	Timothy Raymond Cronin		5367

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Timothy Raymond Cronin
P.O. Box 291
Portage, WI 53901

EXAMINER

HARVEY, DAVID E

ART UNIT	PAPER NUMBER
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2621

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02/23/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/680,830	Applicant(s) CRONIN, TIMOTHY RAYMOND	
	Examiner DAVID E. HARVEY	Art Unit 2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 November 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. Applicant's arguments filed 11/4/2008 have been fully considered but they are not persuasive. The following is noted:

A) In the response filed 11/04/2008 [e.g., the first paragraph on page 2; the first 3 lines on page 4; the sixth paragraph on page 4; the last paragraph on page 5; etc,...], applicant argues/suggests that his invention is directed to a "method" and/or "process". If this position is accurate, then the instant claim(s) should be drafted to positively forth the "active steps of manipulation" which comprise said alleged method/process - i.e., as is required of method/process claims. It is maintained that the "idea" of certifying that a recording is free of subliminal messages, in a verifiable manner, is not itself patentable [e.g., such an "idea" does not fall within one of the statutory classes of patentable inventions defined by section 101 (see paragraph 5 below)].

B) In lines 20-34 on page 4 of the arguments, applicant appears to set forth "steps" that he regards as comprising the process/method of his invention. It is noted, however, that that these cited/argued "steps" are not recited in the pending claim, and that such cited/argued steps are not tied to a machine/apparatus.

C) In the third paragraph on page 2, applicant alleges that "subliminal messages are never undetectable" because, "by definition", they are detected "unconsciously" by the human observer. The examiner notes that in order to "verify" that a recording is free of subliminal messages, it would appear that one needs a method/device that is capable of "consciously"/physically detecting the presence of such subliminal messages in the program. To this point, it is noted that an alleged "subliminal audio message" might be added to the audio of a program at such a low volume as to make it undetectable by any "known" method/machine manner and yet still be arguably detectable, i.e., "unconsciously", by an observer. The instant disclosure, as filed, does not appear to adequately describe/claim a method/process/device by which a program can be "certified" as being free of messages **in such a "verifiable" way** (i.e., physically/"consciously").

D) It is noted that, as currently argued, "certification" appears to refer to the attachment of a "label" to a recording indicating that the recording is free of subliminal messages whereas "verification" appears to refer to some kind of paper trail that may be provided in support of this "certification". Even if true, such terminology does not define active steps of manipulation required of a method claim.

E) The examiner notes that the "evidence" cited in appendices A-C of the response filed 11/4/2008 were not considered because copies of the cited documents were not provided.

2. The fact pattern set forth in lines 18-40 on page 6 of the response filed 11/4/2008 is not understood by the instant examiner. Specifically, it is not clear from the discussion as to: what papers were filed on what dates; as to which of these filed papers are currently of record and which these filed paper may not be of record; and as to what filing date applicant believes he is entitled. Clarification is needed/requested.

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3. **The showing of Jandel (U.S. Patent #6,122,322):**

A) Jandel has been cited because it evidences that it was known to be desirable to protect an observer from subliminal messages present in video, still image, and audio media:

“The protection of an observer from such messages is more difficult to achieve in modern types of communications, such as Internet and videotelephony, for instance. Subliminal messages can be hidden not only in a video sequence, but also in still images, or what the observer considers to be still images, and also audio sequences” [Note lines 32-37 of column 1].

B) In an attempt to provide an observer with such desired “protection”, Jandel discloses a system that comprises:

1) Circuitry for detecting a specific type of subliminal messaging in a received video sequence; and

2) Generating and alarm warning the observer as to the detection of said specific type of subliminal messaging in the received video sequence.

Here it is noted that the system’s lack of detection of this specific type of subliminal messaging in the received video sequence, inherently “**verifies**” that the video sequence in ***free of said detectable type of subliminal messaging***.

C) The examiner notes that despite the fact that Jandel recognized the desire to protect the observer from various other forms of subliminal messages, e.g., such as subliminal messages in audio sequences (note part “A” of this paragraph), the invention disclosed by Jandel only detects/protects the observer from a specific type of message in video sequences. While not explicitly stated in Jandel, the examiner maintains that this is because subliminal messages are, by definition, messages that are intended to be undetectable (i.e., and the majority of subliminal messages are just that – undetectable).

4. The instant invention:

As noted in part "C" of paragraph 1 above, it is maintained that most conventional forms of subliminal messaging are, by definition, undetectable. Given the undetectable nature of most forms of conventional forms of subliminal messaging, a question arises as to the meaning of the expression "**certified verifiable subliminal free ... recordings**" recited in the instant claim of the instant application. That is, if subliminal messages are undetectable, then how can the invention "certify"/"verify" content to be free of subliminal messages - i.e., how can the invention certify/verify recorded media to be free of content that cannot be detected? The following is noted:

A) The examiner maintains that it is unclear from the instant disclosure how and/or by what means/process the recited recording are "certified" to be "subliminal-free" in a way that is "verifiable";

B) To the extent that the invention is understood, as disclosed and explained (note the communication of 6/19/2008), it appears that the invention pertains to a method/process in which audio/visual recording are produced in a "secure production environment", thereby enabling the "manufacturer" of the recordings to "**certify**" (i.e., in some unspecified manner") that the recording, and copies thereof, are free of subliminal messages [note lines 1-7 of paragraph 0004 of the instant specification]. The disclosure/claim further suggest that this unspecified "certification" is somehow "verifiable", however, the instant disclosure fails to describe how such verification is accomplished and/or is possible; i.e., again given the fact that such messages are, by definition, undetectable;

C) It is noted that, contrary to applicant's arguments submitted 6/19/2008), the instant claim of the instant application fails to set forth a "method" of producing the recited recordings in that it fails to positively set forth "steps" for performing a method as required of a method claim. Claim 1 of cited U.S. Patent #6,122,322 to Jandel is hereby cited as being illustrative of the required format of a method claim;

D) Additionally, given the above, it is the examiner's position that to the extent that it is understood, the disclosed/claim invention encompasses the notoriously well known process by which home users conventionally produced/"manufactured" home videos using conventional video cameras and home editing/dubbing units. Namely, conventional home videos, and copies produced therefrom, were conventionally produced in a "secure" home/user environment in which the user (i.e., the "manufacturer" of the home video and copies thereof) was able to certify/verify that the home video recordings and copies thereof, including video and audio recording content, were in fact free of subliminal messages.

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5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. The instant claim (hereafter “claim 1”) is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The instant claim, as currently drafted, is directed to audio/visual “recordings” per se and, as such, fails to set forth a new and useful process, machine, manufacture, or composition of matter, as required under section 101.

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7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Instant "claim 1" is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The following is noted:

As addressed above in paragraph 2 of this Office action, it is unclear from the instant disclosure:

A) How and/or by what means/process the recited recordings are "***certified***" as subliminal-free (i.e., how and by what means/process is such "certification" performed/accomplished/determined?; and

B) How and/or by what mean/process this recited certification is verified and/or "verifiable"?

Clarification is required.

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9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. “Claim 1” is rejected under 35 U.S.C. 102(b) as being anticipated by US Patent #5,526,125 to Mori et al.

As is shown in Figure 1, Mori illustrates an audio/visual production system for producing/“manufacturing” (@ 1) audio/visual recordings and (@ 2) copies thereof in a “secure” user/home environment. As such, the user is implicitly capable of certifying/verifying that the master audio/visual recordings produced thereby (@1), and produced audio/visual recording copies thereof (@2), are free of subliminal messages.

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11. An examination of this application reveals that applicant is unfamiliar with patent prosecution procedure. While an inventor may prosecute the application, lack of skill in this field usually acts as a liability in affording the maximum protection for the invention disclosed. Applicant is advised to secure the services of a registered patent attorney or agent to prosecute the application, since the value of a patent is largely dependent upon skilled preparation and prosecution. The Office cannot aid in selecting an attorney or agent.

A listing of registered patent attorneys and agents is available on the USPTO Internet web site <http://www.uspto.gov> in the Site Index under "Attorney and Agent Roster." Applicants may also obtain a list of registered patent attorneys and agents located in their area by writing to the Mail Stop OED, Director of the U. S. Patent and Trademark Office, PO Box 1450, Alexandria, VA 22313-1450

12. Content of Specification

- (a) Title of the Invention: See 37 CFR 1.72(a) and MPEP § 606. The title of the invention should be placed at the top of the first page of the specification unless the title is provided in an application data sheet. The title of the invention should be brief but technically accurate and descriptive, preferably from two to seven words may not contain more than 500 characters.
- (b) Cross-References to Related Applications: See 37 CFR 1.78 and MPEP § 201.11.
- (c) Statement Regarding Federally Sponsored Research and Development: See MPEP § 310.
- (d) The Names Of The Parties To A Joint Research Agreement: See 37 CFR 1.71(g).
- (e) Incorporation-By-Reference Of Material Submitted On a Compact Disc: The specification is required to include an incorporation-by-reference of electronic documents that are to become part of the permanent United States Patent and Trademark Office records in the file of a patent application. See 37 CFR 1.52(e) and MPEP § 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text were permitted as electronic documents on compact discs beginning on September 8, 2000.
- (f) Background of the Invention: See MPEP § 608.01(c). The specification should set forth the Background of the Invention in two parts:
 - (1) Field of the Invention: A statement of the field of art to which the invention pertains. This statement may include a paraphrasing of the applicable U.S. patent classification definitions of the subject matter of the claimed invention. This item may also be titled "Technical Field."
 - (2) Description of the Related Art including information disclosed under 37 CFR 1.97 and 37 CFR 1.98: A description of the related art known to the applicant and including, if applicable, references to specific related art and problems involved in the prior art which are solved by the applicant's invention. This item may also be titled "Background Art."

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- (g) Brief Summary of the Invention: See MPEP § 608.01(d). A brief summary or general statement of the invention as set forth in 37 CFR 1.73. The summary is separate and distinct from the abstract and is directed toward the invention rather than the disclosure as a whole. The summary may point out the advantages of the invention or how it solves problems previously existent in the prior art (and preferably indicated in the Background of the Invention). In chemical cases it should point out in general terms the utility of the invention. If possible, the nature and gist of the invention or the inventive concept should be set forth. Objects of the invention should be treated briefly and only to the extent that they contribute to an understanding of the invention.
- (h) Brief Description of the Several Views of the Drawing(s): See MPEP § 608.01(f). A reference to and brief description of the drawing(s) as set forth in 37 CFR 1.74.
- (i) Detailed Description of the Invention: See MPEP § 608.01(g). A description of the preferred embodiment(s) of the invention as required in 37 CFR 1.71. The description should be as short and specific as is necessary to describe the invention adequately and accurately. Where elements or groups of elements, compounds, and processes, which are conventional and generally widely known in the field of the invention described and their exact nature or type is not necessary for an understanding and use of the invention by a person skilled in the art, they should not be described in detail. However, where particularly complicated subject matter is involved or where the elements, compounds, or processes may not be commonly or widely known in the field, the specification should refer to another patent or readily available publication which adequately describes the subject matter.
- (j) Claim or Claims: See 37 CFR 1.75 and MPEP § 608.01(m). The claim or claims must commence on separate sheet or electronic page (37 CFR 1.52(b)(3)). Where a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line indentation. There may be plural indentations to further segregate subcombinations or related steps. See 37 CFR 1.75 and MPEP § 608.01(i)-(p).
- (k) Abstract of the Disclosure: See MPEP § 608.01(f). A brief narrative of the disclosure as a whole in a single paragraph of 150 words or less commencing on a separate sheet following the claims. In an international application which has entered the national stage (37 CFR 1.491(b)), the applicant need not submit an abstract commencing on a separate sheet if an abstract was published with the international application under PCT Article 21. The abstract that appears on the cover page of the pamphlet

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published by the International Bureau (IB) of the World Intellectual Property Organization (WIPO) is the abstract that will be used by the USPTO. See MPEP § 1893.03(e).

- (l) Sequence Listing. See 37 CFR 1.821-1.825 and MPEP §§ 2421-2431. The requirement for a sequence listing applies to all sequences disclosed in a given application, whether the sequences are claimed or not. See MPEP § 2421.02.

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13. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DAVID E. HARVEY whose telephone number is (571) 272-7345. The examiner can normally be reached on M-F from 6:00AM to 3PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Marsha D. Banks-Harold, can be reached on (571) 272-7905. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/DAVID E HARVEY/

Primary Examiner, Art Unit 2621

**DAVID E HARVEY
Primary Examiner
Art Unit 2621**